



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/455,683	05/31/1995	GRAEME I. BELL	ARCD:177/WIM	8952

7590 03/12/2002

DAVID L. PARKER
FULBRIGHT & JAWORSKI
600 CONGRESS AVENUE SUITE 2400
AUSTIN, TX 78701

EXAMINER

LANDSMAN, ROBERT S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/455,683

Applicant(s)

BELL ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 91-96 is/are allowed.
- 6) ☒ Claim(s) 97-143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Formal Matters

A. The request filed on 12/10/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/455,683 is acceptable and a CPA has been established. An action on the CPA follows.

B. Claims 91-143 are pending in the application.

C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Claim Rejections - 35 USC § 112, first paragraph – written description

A. Claims 97-102, 109, 112-114 and 123 remain rejected under 35 USC 112, first paragraph, and new claims 137 and 143 are also rejected for the reasons already of record on pages 3-4 of the Office Action dated 1/30/01. Applicants argue that they were in possession of SEQ ID NO:11 at the time the application was filed. The Examiner does not question that Applicants were in possession of SEQ ID NO:11 at the time of filing. The issue is that Applicants were only in possession of a partial sequence of a human opioid receptor at the time of filing, not the full-length receptor. The claim language recites a screening method in which an opioid receptor is used which comprises at least 30 contiguous bases of SEQ ID NO:11. The use of the term "comprises" reads on the claimed process using the full-length opioid receptor encoded for by additional residues to those of SEQ ID NO:11, of which Applicants were not in possession. While it is true that patent law does not require applicants to limit their invention to the embodiments reduced to practice, it is clear that Applicants were not in possession of the full-length human sequence. If Applicants were in possession of the full-length opioid sequence, they would likely be entitled to particular variants. However, the fact that Applicants were not in possession of the full-length receptor is an important one in this case since it appears that Applicants identified only a portion of

Art Unit: 1647

the sequence and intend to hunt for the remaining portion of the DNA while inhibiting those who may actually have identified the full-length receptor from claiming it. As stated in previous Office Actions, Applicants would either need to use "consisting of" language in order to prevent the claims from reading on the full-length receptor, or to recite that the nucleic acids of the claimed processes would only be able to "comprise" up to the full-length of SEQ ID NO:11.

3. Claim Rejections - 35 USC § 112, first paragraph - scope

A. The rejection of claims 91-102, 109, 112-114 and 115-136 under 35 USC 112, first paragraph, have been withdrawn since Applicants have amended the claims to recite "bind to."

B. Claims 103-109, 112-114, 129-132, 134 and 135 remain rejected under 35 USC 112, first paragraph, and claims 117, 125-128 and 137-142 are also rejected for the reasons already of record on page 4 of the Office Action dated 1/30/01. Applicants have not amended the claims to recite the amino acid residue numbers (e.g. residues 222-231 of SEQ ID NO:2), but have recited the single letter amino acid abbreviations for the residues in the second extracellular loop, which would require a SEQ ID NO since these sequences are greater than 4 amino acids in length. Applicants should amend the claims to recite the amino acid residue numbers of the recited loops (e.g. residues 222-231 of SEQ ID NO:2), unless the loop has a specific SEQ ID NO. (e.g. SEQ ID NO:17).

4. Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A. Claims 138-142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are confusing since claim 137, from which claims 138-142 depend, recites SEQ ID NO:11, which is a partial human sequence, whereas claims 138-142 now recite SEQ ID NO:1, a mouse sequence. Furthermore, it is not clear what SEQ ID NO:14, recited in claim 141, represents. The

Art Unit: 1647

Examiner requests Applicants to clarify if SEQ ID NO:14 represents the third extracellular loop of SEQ ID NO:1.

5. Conclusion

- A. Claims 91-96 are allowable.
- B. Claims 103-108, 116-122, 125-132, 134 and 135 would be allowable if Applicants amend the claims to recite the appropriate residue numbers, or SEQ ID NO, of the recited extracellular loops, instead of the one-letter abbreviations.
- C. Claims 97-102, 112-114, 123 and 137-143 are not allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Advisory information

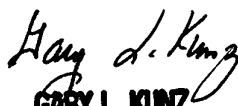
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
March 11, 2002


GARY L. KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600